

## **REMARKS**

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claim 19 has been amended. No new matter has been added. Thus, claims 1-20 are currently pending in the application and subject to examination.

### **I. Claim Objection**

In the Office Action mailed August 29, 2006, the Examiner objected to claim 19. Claim 19 has been amended responsive to this objection. If any additional amendment is necessary to overcome this objection, the Examiner is requested to contact the Applicant's undersigned representative.

### **II. Claim Rejections**

Claims 1-3, 5, 6, 9-12, 14, 15, and 18-20 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Publ. No. 20010012761 to Mitama et al. ("Mitama"). Claims 4 and 13 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Publ. No. 2002/0025839 to Usui ("Usui"). Under 35 U.S.C. § 103(a), the Examiner rejected claims 7-8 and 16-17 as being unpatentable over Mitama in view of U.S. Publ. No. 2005/0119014 to Bandell et al. ("Bandell"). The Applicants hereby traverse the rejections as follows.

#### **A. Claims 1, 5-10, and 14-18**

Applicants' invention as set forth in claim 1 is directed to a portable terminal comprising an information transmission reception part, a radio communication part, and an information processing part, wherein the portable terminal can effect transmission

and/or reception of information relative to another portable terminal by any of a master terminal made up of an information transmission and/or reception part and an information processing part; and a slave terminal made up of the information transmission and/or reception part and a radio communication part; and a normal terminal configured by combining the radio communication part with the information processing part via the information transmission and/or reception part.

i. Benefits of the Present Invention

First, the invention recited in claim 1 allows multifunctional enhancement to communication functions of the claimed portable terminal. Second, the invention enables a portable terminal with a master slave function capable of being downsized to be lightweight with high-function, high-sensitivity, and low current consumption. Third, the invention enables a master slave portable telephone system by rendering a transmission and/or reception mode of information to be multi-functional with enhanced communication function.

The portable terminal recited in claim 1 can effect both long-range communication using a public circuit network using the radio communication part and short-range communication between portable terminals using the information transmission and/or reception part. Thus, the portable terminal more conveniently copes with various call modes, locations, and portable terminals through which a call may be effected, as discussed in paragraph [0059] of the specification.

The present invention allows a master slave portable telephone system to be configured so that the portable terminal is connected to an external antenna by the provision of a station part having the external antenna and the installation of the

portable terminal in the station part. This enables a stable communication state even in a weak electric field zone.

Further, configuring the system so that the portable terminal is allowed to function as a master terminal or a slave terminal within communication range of the information transmission and/or reception part, and the portable terminal is allowed to function as a normal terminal outside of that communication range, provides a stable radio call or transmission and/or reception of information while avoiding unstable communication in the weak electric field zone.

If the master slave portable telephone system were provided with a second cell charger built into the portable terminal at the station part, it is possible to stabilize a call in the weak electric field zone as well as to charge the secondary cell.

The master slave portable telephone system according to the present invention allows high functions such as mass data communication, high image quality display, high-grade sound quality and so forth to be utilized by combining a high-function portable terminal and a portable terminal having a normal function. This allows high-grade communication in areas having a small number of base stations or a weak electric field zone. Thus, it is possible to effect communication according to the mode, location, and portable terminal through which a call is effected by using the combination of a low performance portable terminal capability and a high-function portable terminal capability rather than only using a high-function portable terminal.

The present invention also enables large capacity data communication, wherein the portable terminal can save received large capacity data in a slave terminal while maintaining communication with the base station, such as a phone call function.

Mitama teaches a portable radio communication apparatus. However, in Mitama, the portable phone body and the sub-apparatus are mechanically separated—the portable phone body is a distinct apparatus from the sub-apparatus. Mitama does nothing but transmit or receive a sub-apparatus control signal and a response signal by using a weak electric wave between the portable radio communication apparatus and the separate sub-apparatus. The portable radio communication apparatus in Mitama is not comprised within one portable terminal, as recited in claim 1.

Bandell fails to cure the deficiency in Mitama.

For at least this reason, the Applicants submit that claim 1 is allowable over the cited art. For similar reasons, the Applicants submit that claim 10 is likewise allowable. As claims 1 and 10 are allowable, the Applicants submit that claims 5-9 and 14-18, which depend from allowable claims 1 and 10, are therefore also allowable for at least the above noted reason and for the additional subject matter recited therein.

Regarding claims 6 and 15, the Applicants submit that Mitama further does not disclose or suggest the portable terminal comprising a switching part by combining the radio communication part with the information processing part or combining the information transmission and/or reception part with the radio communication part or information processing part, as recited in claims 6 and 15.

Regarding claims 7, 8, 16, and 17, the Applicants submit that Bandell merely discloses a structure wherein a master portable unit is connected to a base unit provided with a charger and an antenna for communicating wirelessly with the base station. As discussed above, Mitama's portable phone body and sub-apparatus are mechanically separate. Thus, even if Bandell and Mitama were combinable, which is

not admitted, the combination still fails to disclose the invention recited in claims 7, 8, 16, and 17.

Regarding claims 9 and 18, the Applicants submit that Mitama further does not disclose or suggest a portable terminal wherein the information transmission and/or reception part effects transmission and/or reception of information by radio or wire, as recited in claims 9 and 18.

B. Claims 2 and 11

Applicants' invention as set forth in claim 2 is directed to a portable terminal comprising an information transmission reception part, a radio communication part, and an information processing part, wherein a first communication mode capable of effecting transmission and/or reception of information relative to another portable terminal by combining said radio communication part with said information processing part via said information transmission and/or reception part; a second communication mode capable of effecting transmission and/or reception of information relative to another portable terminal using said information transmission and/or reception part and said information processing part; a third communication mode capable of effecting transmission and/or reception of information relative to another portable terminal using said information transmission and/or reception part and said radio communication part; and wherein said first, second, and third communication modes are switched.

This allows a portable terminal to selectively switch between a communication mode as a normal terminal and another communication mode as it communicates between itself and another communication terminal. This conveniently provides a

portable terminal capable of selecting a desired communication mode, as described in the specification in paragraph [0060] of the specification.

The switching part for combining the information transmission and/or reception part to the radio communication part or the information processing part allows a single information transmission and/or reception part to be shared by the radio communication part and the information processing part, thereby simplifying the configuration of the portable terminal, as described in paragraph [0075] of the specification.

Mitama does not disclose or suggest "a" portable terminal with the claimed structure wherein the claimed first, second, and third modes are switched. Mitama merely discloses a communication mode for transmitting a signal (transmitting and/or receiving information) from the sub-apparatus to the portable phone body with the use of a controller and an easy radio device. As noted above, the phone body and the sub-apparatus in Mitama are mechanically separate, discrete apparatuses and are not comprised within one portable terminal, as recited in claim 2.

For at least these reasons, the Applicants submit that claim 2 is allowable over the cited art. For similar reasons, the Applicants submit that claim 11 is likewise allowable over the cited art.

C. Claims 3 and 12

Applicants' invention as set forth in claim 3 is directed to a portable terminal comprising a radio part provided with an information transmission and/or reception part for effecting transmission and/or reception of information and effecting communication by radio; and a control part provided with another information transmission and/or reception part for effecting transmission and/or reception of information and processing

the information; wherein said portable terminal effects communication by effecting transmission and/or reception of information relative to another portable terminal by both said radio part and said control part, and/or effects transmission and/or reception of information relative to another portable terminal by either said radio part or control part.

This allows the portable terminal to effect transmission and/or reception of information in the radio part for effecting communication by radio and to effect transmission and/or reception of information in the control part for processing information. Thus, the portable terminal can effect transmission and/or reception of information between itself and another portable terminal with the radio and the control part being independent of each other, as described in paragraph [0061] of the specification.

In Mitama, the portable phone body and the sub-apparatus are mechanically separate, discrete apparatuses and are not comprised in one portable terminal. Thus, the Applicants submit that Mitama does not disclose or suggest “a” portable terminal comprising a radio part and a control part configured as recited in claim 3.

For at least this reason, the Applicants submit that claim 3 is allowable over the cited art. For similar reasons, the Applicants submit that claim 12 is likewise allowable over the cited art.

D. Claims 4 and 13

Applicants’ invention as set forth in claim 4 is directed to a portable terminal comprising a radio part and a control part, wherein the radio part and the control part can effect transmission and/or reception of information relative to another portable

terminal via first information transmission and/or reception parts, and either the radio part or the control part can effect transmission and/or reception of information relative to another portable terminal using second information transmission and/or reception part.

By providing the radio part with a first and second information transmission and/or reception part and providing the control part with a first and second information transmission and/or reception part, a complex call and transmission and/or reception of information can be effected by using a normal terminal configuration by combining the radio part with the control part using the first information transmission and/or reception part and the enhanced portable terminal capable of effecting transmission and/or reception of information relative to another portable terminal using the second information transmission and/or reception and so on.

Usui teaches a mobile communication device provided with a wireless section (3, 6) connected to an antenna for transmitting and/or receiving, two information transmitting and/or receiving sections via the 1<sup>st</sup> and 2<sup>nd</sup> wireless sections (3, 6), and a control section (5) for performing operation control of the communication device. (See Usui paragraph 32, lines 1-5, paragraph 33, lines 5-8, and Figure 1).

However, in Usui, a mobile phone device is a phone terminal unit, and the mobile phone system comprises the phone terminal unit and a main body separable therefrom.

In addition, Usui is not provided with the information transmitting and/or receiving section within each of the wireless section and the control section.

Thus, the Applicants submit that Usui does not disclose or suggest the portable terminal as recited in claim 4.



For at least this reason, the Applicants submit that claim 4 is allowable over the cited art. For similar reasons, the Applicants submit that claim 13 is likewise allowable.

E. Claim 19

For reasons similar to those described above for claim 1, the Applicants submit that Mitama does not disclose or suggest a master slave portable telephone system, provided with first and second portable terminals comprising an information transmission and/or reception part, a radio communication part, and an information processing part, in connection with the other features recited in claim 19.

Mitama discloses two portable terminals, a portable telephone apparatus and a sub-apparatus, that communicate through a Bluetooth, and an easy radio device connecting to an antenna (radio communication unit) (13) for performing radio communication (transmitting radio waves) with the other apparatus. (See Mitama, Figure 1). However, Mitama is different than the invention recited in claim 19 because the portable phone body and the sub-apparatus are mechanically separate, discrete apparatuses and are not comprised within one portable terminal, as recited in claim 19.

For at least these reasons, the Applicants submit that claim 19 is allowable over the cited art. For similar reasons, the Applicants submit that claim 20 is likewise allowable over the cited art.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification

must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 19. This is an insufficient showing of motivation.

### **CONCLUSION**

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into condition for allowance, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 with reference to Attorney Docket No. 026974-00001.

Respectfully submitted,

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